L

SUPRE

LIBRARY
UPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
SEP 9 1968
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 315

MASON HOFFENBERG,

Petitioner,

v.

ABRAHAM L. KAMINSTEIN, REGISTER OF COPYRIGHTS,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF OF THE AUTHORS LEAGUE OF AMERICA, INC. *AS AMICUS CURIAE*

IRWIN KARP
Attorney for The Authors League of America, Inc., as Amicus Curiae
120 Broadway
New York, New York 1005

32 CASE PRESS INC., 421 HUDSON ST., N.Y.—ORegon 5-4540

INDEX

PAGE

Interest of the Authors League 1

Summary of Argument 1

The Question 2

The Conflicting Interpretations of Sections 10 and 16 3

POINT I—The Copyright Office Construction Would Render Section 16 Unconstitutional 4

The Fifth Amendment 4

The Copyright Office Version Poses Other Constitutional Conflicts 8

POINT II—Section 16 does not require that the first edition of Petitioner's novel be manufactured in this country in order that he secure copyright under Section 10 10

CONCLUSION 15

TABLE OF CASES CITED

Ashwander v. Tennessee Valley Authority, 297 U.S. 288 8

Blodgett v. Holden, 275 U.S. 142 8

Crowell v. Benson, 285 U.S. 22 8

Fed. Trade Comm. v. Amer. Tobacco Co., 264 U.S. 298 7

Louisiana v. N.A.A.C.P., 366 U.S. 293 9

Lucas v. Alexander, 279 U.S. 573 8

Missouri Pacific R.R. Co. v. Boone, 270 U.S. 466 ... 8

PAGE

Panama R.R. Co. v. Johnson, 264 U.S. 375 8

Richmond Co. v. United States, 275 U.S. 331 8

Schneider v. Rusk, 377 U.S. 163 (1963) 4, 7

United States v. Jim Fuey Moy, 241 U.S. 394 7

United States v. Witkovich, 353 U.S. 194 8

Washingtonian Pub. Co., Inc. v. Pearson, 306 U.S. 30 12

MISCELLANEOUS

First Amendment 2, 4

Fifth Amendment 2, 4

IN THE

Supreme Court of the United States

October Term, 1968

MASON HOFFENBERG

Petitioner,

v.

ABRAHAM L. KAMINSTEIN, Register of Copyrights,

Respondent.

BRIEF OF THE AUTHORS LEAGUE OF AMERICA, INC. *AS AMICUS CURIAE*

Interest of the Authors League

The Authors League of America is a national society of professional writers. It files this brief in support of the Petition, with the consent of the parties, because the question involved is of gravest importance to many American authors. If the Copyright Office interpretation of Sec. 16 of the Copyright Act. (17 U.S.C. 16) is allowed to stand, it would deprive American authors of United States copyrights in several books of enduring literary value which were first published abroad during the last six decades.

Summary of Argument

The Authors League respectfully submits that the Petition should be granted. It presents an important question

under the Copyright Act, and the decision below, if not reversed, would cause great injury to writers who have made valuable contributions to the literature of this country and the world—without any purpose except to inflict that injury.

The Circuit Court's decision sustaining the Copyright Office construction of Sec. 16 should be reviewed and reversed. That construction is wrong. Moreover it so unjustifiably and senselessly discriminates against American book authors, and constitutes such a burden on free expression, as to be unconstitutional under the Fifth and First Amendments; or at least raises such a serious question of constitutionality as to warrant rejecting it. This constitutional conflict is unnecessary since the correct interpretation of Sec. 16 accomplishes its purposes without discrimination or destruction of copyrights of American book authors. And, paradoxically, the correct interpretation does not thwart the purpose of Sec. 16—while the Copyright Office version does.

The Question

The question is whether Sec. 16 imposes on American authors an additional requirement for obtaining United States copyright in books and periodicals—namely that the first edition must be manufactured in this country.

Sec. 16 does not state any such condition. The Copyright Office reads it in by a process of constructions. Concededly, American manufacture is not required to obtain copyright in (i) music, plays or other classes of works by American or foreign authors, or (ii) in books in English by authors of most other countries, or (iii) books in other languages by foreign authors.

The Conflicting Interpretations of Sections 10 and 16

The Petitioner and the Copyright Office differ as to the correct interpretation of Sections 10 and 16 of the Copyright Act. Section 10 provides that any person

> "may secure copyright for his work by publication thereof with the notice of copyright required by this title. . . ."

This is the only requirement prescribed in the Act for obtaining copyright in a book or periodical. (Music, plays, and certain other works may be copyrighted by publication under Sec. 10: or by registration prior to publication, under Sec. 12.)

Petitioner contends: That publication of an American author's book with proper copyright notice secures for him (as it does for foreign authors) the United States copyright, regardless of where the first copies are manufactured or published. If the first copies are manufactured abroad, he may not import them (Secs. 16 and 107); and, he may not sue for infringements here until he deposits two copies of an American manufactured edition in the Copyright Office (Secs. 13, 16, and 17). If he wishes to sue for infringements before an edition is manufactured here [or import up to 1500 foreign copies], he may file for *ad interim* copyright (Sec. 22).

The Copyright Office contends: That in addition to complying with Sec. 10, an American author of books must also have the first edition manufactured here to obtain copyright in his book. If it is manufactured abroad, he can only obtain copyright by filing for *ad interim* copyright under Sec. 22 and then publishing an American manufactured edition within five years (Sec. 23).

POINT I

The Copyright Office Construction Would Render Section 16 Unconstitutional.

The Fifth Amendment

For the reasons indicated in Point II, we submit that the Copyright Office's construction of Section is erroneous. Moreover, if Sec. 16 is construed as the Copyright Office contends, it would be unconstitutional under the Fifth Amendment.

In *Schneider* v. *Rusk*, 377 U.S. 163, 168 (1963), the Court ruled:

> "Moreover, while the Fifth Amendment contains no equal protection clause, it does forbid discrimination that is 'so unjustifiable as to be violative of due process.' *Bolling* v. *Sharpe*, 374 U.S. 497, 499."

The statute held unconstitutional in *Schneider* discriminated between two classes of American citizens living abroad, favoring the native born over the naturalized. Under the Copyright Office interpretation, Sec. 16 discriminates against American authors of books that are manufactured abroad—denying them a fundamental right granted to: (i) foreign authors of books manufactured abroad and (ii) American or foreign authors of other classes of copyrightable works manufactured abroad. The discrimination is so unjustifiable as to violate the due process requirements of the Fifth Amendment.

(i) Foreign authors of books in other languages obtain full (28 years) copyright under Sec. 10 by publication with proper notice—the first edition may be manufactured and sold abroad, or here. Foreign authors of books in English

also obtain full copyright by publication with appropriate notice if they are citizens of countries adhering to the Universal Copyright Convention—the first edition may be manufactured and sold abroad, or here. (Most English speaking countries adhere to the Convention.)

Thus these foreign authors are not required to have the first (i.e. copyright-securing) edition manufactured in the United States; they are not required to file for *ad interim* copyright or secure an American made edition within 5 years of first publication; they are free to have all editions manufactured outside the United States; and they may import copies in unlimited quantities.

But American book authors, under the Copyright Office version of Sec. 16, are denied the same right to secure United States copyright by publication of a foreign manufactured edition. This discriminates against the American Author who may only be able to have a book published in another country, because he lives there or cannot find an American publisher willing to issue it. The *ad interim* clause does not eliminate this discriminatory treatment. It requires the author to obtain an American made edition within 5 years or lose all protection. The author may be unable to find an American publisher in time; and would then have to incur the additional expense of publishing an edition here himself or lose his copyright.

(ii) Under the Copyright Office construction, Sec. 16 also discriminates between American authors of books and authors (American and foreign) of all other classes of works. The American (or foreign) author of a musical composition, play, motion picture or any other work (except a book or periodical) obtains full copyright under Sec. 10 by pub-

lication of his work, with notice,—even though the first copies are manufactured or produced abroad. He need not comply with Sec. 22; he never need manufacture copies here; he can import foreign copies without limitation; and he can sue for infringements here, even though every copy sold in this country was manufactured abroad.

(iii) There is absolutely no justification for interpreting Sec. 16 to deny American book authors the right, granted other American and foreign authors, to secure copyright on publication of a foreign manufactured edition. As indicated in Petitioner's brief, the purpose of Sec. 16 was to give American printers and book manufacturers the opportunity to produce the copies to be sold in the American market. That purpose is secured by preventing the importation of foreign manufactured copies (Sec. 107); by requiring that American authors may not sue for infringement of copyright until an American edition has been manufactured; and by requiring that if such an author of a book copyrighted by publication abroad wished to sell copies in the American market, he must have these copies manufactured by an American printer.

On the other hand, the Copyright Office interpretation of Sec. 16—denying copyright to American books first manufactured abroad—defeats the very purpose of the Section. If an American author's book is thrown into the public domain, under the Copyright Office version, the exclusive right to produce it for the American market is lost to American printers and book manufacturers. Once in the public domain the book is no longer subject to the requirements of Sec. 16 and Sec. 107—and foreign made copies can be imported without any numerical limitations.

The lack of justification for the Copyright Office construction is further emphasized by the fact that while importation of foreign made books has ceased to be a threat, the foreign manufacture of motion pictures and other works by American authors has had an increasingly serious effect on domestic producers of these works. Yet the Congress has not imposed the requirement of American manufacture as a condition for obtaining copyright in these classes of works.

We submit that if Sec. 16 were construed to deny American authors of books the same right to secure copyright which is granted to foreign authors of books and to American and foreign authors of other works, the Section would violate the Fifth Amendment's prohibition against discrimination "so unjustifiable as to be violative of due process." (*Schneider* v. *Rusk, supra*, at p. 168).

At the very least, the Copyright Office construction would create such doubts as to the constitutionality of Sec. 16 as to render it inacceptable. As Justice Holmes said, in *United States* v. *Jin Fuey Moy*, 241 U.S. 394, 401:

> "A statute must be construed, if fairly possible, so as to avoid not only the conclusion that it is unconstitutional but also grave doubts upon that score. (*United States* v. *Delaware & Hudson Co.*, 213 U.S. 366, 408)"

In *Fed. Trade Comm.* v. *Amer. Tobacco Co.*, 264 U.S. 298, Mr. Justice Holmes said:

> "We cannot attribute to Congress an intent to defy the Fourth Amendment or even to come so near to doing so as to raise a serious question of constitutional law." (P. 307)

In *Crowell* v. *Benson*, 285 U.S. 22, 62, Chief Justice Hughes said:

> "When the validity of an act of the Congress is drawn in question, and even if a serious doubt of constitutionality is raised, it is a cardinal principle that this Court will first ascertain whether a construction of the statute is fairly possible by which the question may be avoided."

See also:

> *United States* v. *Witkovich*, 353 U.S. 194, 201; *Ashwander* v. *Tennessee Valley Authority*, 297 U.S. 288, 348; *Panama R.R. Co.* v. *Johnson*, 264 U.S. 375, 390; *Missouri Pacific R.R. Co.* v. *Boone*, 270 U.S. 466, 471, 472; *Richmond Co.* v. *United States*, 275 U.S. 331, 346; *Blodgett* v. *Holden*, 275 U.S. 142, 148; *Lucas* v. *Alexander*, 279 U.S. 573, 577.

We respectfully submit that "a construction of the statute is fairly possible by which the (constitutional) question may be avoided"—namely, the construction urged by the Petitioner.

The Copyright Office Version Poses Other Constitutional Conflicts

However construed, Sec. 16 penalizes American authors of books, denying them rights (to import foreign copies and sue without obtaining an American edition) which are granted to other American and foreign authors. As a punitive section, it should be narrowly construed in favor of the American book author; it should not be broadly construed, as the Copyright Office does, also to deprive him of the fundamental right to secure copyright.

The Copyright Office version of Sec. 16 violates the spirit, if not the very letter, of the Constitutional provision (Art.

I, Sec. 8) that authors be secured "the *exclusive* right to their respective writings. . . ." (emphasis supplied).

Moreover the Copyright Office version will, in some instances, impose a serious restraint on freedom of speech and press. Books and articles by American authors are published abroad for various reasons. One is that an author sometimes cannot find an American publisher willing to issue his book*. It is not uncommon that a work expressing politically or artistically controversial opinions sometimes must be first published in another country. The denial of American copyright under the Copyright Office version of Sec. 16 can restrain that publication. Faced with the loss of American copyright in his book, the American author may be forced to withhold it from publication anywhere until he can find an American publisher (which may mean a delay of years). Application for *ad interim* copyright involves the same threat, since the failure to publish an American edition within five years forfeits copyright.

This restraint on publication, by threat to copyright, does not arise under the construction of Sec. 16 urged by the Petitioner. Moreover this construction accomplishes the purpose of the section more effectively than does the Copyright Office version. We submit that the principle restated in *Louisiana* v. *N.A.A.C.P.*, 366 U.S. 293, warrants rejection of the Copyright Office construction. There the Court said:

> "We are in an area where, as *Shelton* v. *Tucker*, 364 U. S. 479, emphasized, any regulation must be highly selective in order to survive challenge under the First Amendment. As we there stated: '. . . even

---

* This problem is compounded by the continuing reduction in the number and independence of American book publishers as the result of mergers and acquisitions of publishing firms by large conglomerate corporations which are scarcely interested in publishing controversial books.

though the governmental purpose be legitimate and substantial, that purpose cannot be pursued by means that broadly stifle fundamental personal liberties when the end can be more narrowly achieved.' ''

POINT II

Section 16 does not require that the first edition of Petitioner's novel be manufactured in this country in order that he secure copyright under Section 10.

Plaintiff's novel ''Candy'' was first published in France with the proper notice of copyright. According to the provisions of Section 10, this automatically secured United States copyright in the work. Section 16 does not require, as a condition for securing copyright, that the first edition be manufactured in the United States. However, the Copyright Office, erroneously contending that American manufacture is a condition for securing copyright under the Act, denied registration under Sections 13 and 17.

We submit that the Copyright Office's interpretation of the Act is erroneous for these reasons.

(i) *Sec. 10.* The Section specifies the method by which an author may obtain copyright in his ''work''—i.e., ''by publication thereof with the notice of copyright required by this title. . . .'' This is the sole requirement imposed by the Section.

Section 10 does not require that the first edition, by which copyright is secured, be manufactured in this country. Concededly, the publication of an American author's musical composition or play in a foreign country with

proper notice of copyright—in a foreign made edition—automatically secures United States copyright under Sec. 10. The Section makes no distinction between classes of authors or classes of works. It applies to all copyrighted works by all authors. It does not exclude books, or American authors.

Sec. 10 does not say that its requirement is subject to additional conditions set forth in either Sec. 16 or Sec. 22. And, neither Sec. 16 or Sec. 22 state that, in addition to the requirement of Sec. 10, the American manufacture of the first edition is a condition for obtaining copyright in an American book. Yet, if such a condition were intended by Congress, it was important enough (and easy enough) to be stated explicitly.

(ii) *Sec. 16.* The operative language of the section states that "all copies accorded protection under this title . ... shall be" printed and bound in the United States. The Copyright Office claims this requires, as a condition for securing copyright, that the first edition of an American author's book must be manufactured here.

The Copyright Office is wrong. The Section does not state any requirement for "secur[ing] copyright"; and the operative language of the Section does not use the word "copyright" at all. On the contrary it speaks of "the text of all copies accorded protection." Unlike Sec. 10, Sec. 16 does not deal with the process of securing copyright. Rather, like Sec. 13 it is a provision dealing with remedies, and the right to enforce a copyright already secured under Sec. 10. Sec. 13 requires the deposit of copies and registration as a condition for suing to protect the copyright "secured by publication of the work with the notice of copyright as provided in sec-

tion 10 . . .'' These events may occur years after the work is copyrighted by publication. *Washingtonian Pub. Co., Inc.* v. *Pearson*, 306 U.S. 30.

Moreover, a condition for securing copyright, read in by the Copyright Office, cannot be fairly or logically construed from the language of Sec. 16 (read alone or in conjunction with Sec. 22.)

For one thing, the operative language of Sec. 16 cannot be read as a condition applying solely to the copies constituting the first edition of a work. It makes no distinction between copies of the first edition, and the copies of subsequent editions—it applies to all copies. If an American author's book were first published here, in an American-manufactured edition, it would (according to the Copyright Office interpretation) have secured copyright. But if subsequent editions of the book were manufactured abroad, the operative language of Sec. 16 would apply to these copies with the same effect as it would have if the first edition were manufactured abroad. If Sec. 16 were construed as a requirement that, to secure copyright, the *first* edition must be manufactured here, it would logically follow that once that condition were complied with, *subsequent* editions could be manufactured abroad and imported. Sec. 107 would not prevent importation since it bars only the importation of copies not manufactured in accordance with Sec. 16, and according to the Copyright Office Sec. 16 would not apply to such subsequent editions. Yet this would defeat the purpose of the clause, which is to preserve for American printers the opportunity to manufacture those copies of an American author's book which are sold in this country.

Clearly, then, the language of Sec. 16 cannot be interpreted as a condition for securing copyright because the

same language applies to later foreign editions of books which were *first published* in American-manufactured first editions—and had already secured copyright. It is impossible to distill from the turgid language of Sec. 16 *two* different sets of conditions, one applying to the first edition, the other to subsequent editions—yet that is what the Copyright Office is attempting to do.

We believe that the only construction of Sec. 16, permitted by its language and logic, is that (i) it requires that the copies of an American author's book which are sold in the United States must be manufactured here (except for the 1500 copies he may import, if he elects to obtain *ad interim* copyright under Sec. 22); and (ii) that if the first edition, by which the author obtained copyright under Sec. 10, is published abroad he may not sue for infringement of copyright in this country until he has obtained an American manufactured edition and deposited 2 copies in the Copyright Office, pursuant to sec 13. (One reason for choosing to obtain *ad interim* copyright is that it permits the author to sue for infringement during the 5-year period even though an American manufactured edition has not been published.)

(iii) *Sec. 22.* The Copyright Office relies on its interpretation of Sec. 16 to deny registration to plaintiff. It does not contend that appellant's failure to comply with Sec. 22, deprived him of his copyright—but rather that since he did not choose this alternative means, he lost his copyright under its interpretation of Sec. 16.

We agree with the petitioner that Sec. 22 is a permissive section. It permits the author of a book first published abroad to import 1500 copies despite the restriction of the Manufacturing Clause; and, as we have noted, where the first edition is manufactured abroad, it offers a means of

avoiding the requirement of depositing American made copies (under Sec. 13) as a condition of suing for infringements occurring during the *ad interim* period. But it is clear from the language of Sec. 22 that it is not a mandatory requirement for procuring copyright in a book first published abroad by an American author. Its language in no way provides, or suggests, that it is a compulsory alternative to securing copyright under Sec. 10.

Moreover, the Copyright Office has conceded that where the first edition of a work published abroad is manufactured in the United States, Sec. 22 does not apply—and the author obtains copyright under Sec. 10. This concession necessarily proceeds from the premise that Sec. 22 is permissive. There is no provision for such an exception in the Section. It does not speak of the place of manufacture. It only deals with books "first published abroad." Consequently, if it were mandatory, then a book in English first published abroad would have to be registered for *ad interim* copyright even though the edition had been manufactured in the United States.

In addition, Congress has made it clear that Sec. 22 is permissive. In 1954, it amended Sec. 9 of the Act to exempt foreign authors (from countries adhering to the Universal Copyright Convention) from certain sections of the Act, including Sec. 16. However, no exemption was granted from Sec. 22 or Sec. 23. This establishes that Congress construed Sec. 22 as being entirely permissive. If it were mandatory, foreign authors would still be required to file *ad interim* copyright for books in English when published broad—because the section does not deal with place of manufacture but with place of publication. However, the Copyright Office concedes that such authors are not required to comply with Sec. 22 because they are not affected by Sec. 16.

CONCLUSION

It is respectfully submitted that a Writ of Certiorari should be granted and the decision of the Court of Appeals should be reversed.

IRWIN KARP
Attorney for the Authors League of America, Inc., Amicus Curiae